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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,701	02/08/2002	David Z. Lubowski	5804.02	2673
20686	7590	06/16/2005		
DORSEY & WHITNEY, LLP INTELLECTUAL PROPERTY DEPARTMENT 370 SEVENTEENTH STREET SUITE 4700 DENVER, CO 80202-5647			EXAMINER LEUBECKER, JOHN P	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/071,701

Applicant(s)

LUBOWSKI, DAVID Z.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 12-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10 and 12-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/15/05</u> | 6) <input type="checkbox"/> Other: _____  |

*Claim Objections*

1. Claims 25, 30 and 40 are objected to because of the following informalities: as to claim 25, line 6, --and-- should be inserted between "configuration" and "a"; as to claim 38, line 2, after "36," insert --wherein--; as to claim 40, line 2, delete "integral" (since it was not previously used to describe the insufflation means). Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-10 and 12-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose how the observation window (e.g., 14, Fig.2) is "adapted to isolate the light source from the lumen" as now claimed in claim 41. The specification specifically states that the light source is isolated from the lumen by fiber optic light head (5) (note page 9, lines 8-11), which is equated with the coupling means (page 7, lines 16-17). (It is noted that Applicant's "connection means" in claim 41 is actually referring to the disclosed coupling means and not the various connection means (i.e., page 4, line 5) disclosed throughout the specification). Since the specification offers no other details as to the connection

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of the light source to the fiber optic light head, it is explicitly implied that there is no direct exposure of the light source to the lumen in Applicant's device. Thus, the light source is inherently isolated from the lumen *by the fiber optic light head* (connection means). Claiming that the observation window isolates the light source from the lumen implies a structure which has not been particularly set forth in the disclosure.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10 and 12-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 41, recitation of "a light head housing the light source" causes confusion as to how one is to interpret the "connection means". Applicant appears to use "connection means" to refer to what the specification labels as the "coupling means" (page 7). The "coupling means" is equated to the fiber optic light head (page 7) which by definition houses the light source (page 7). Thus, since a connection means (coupling means) has already been claimed, reference to a "light head housing the light source" in a way that implies that it is a different element makes one wonder as to what the "connection means" is referring.

As to claims 2-8 and 18-20 reference to the contamination prevention means is indefinite since it lacks antecedent basis.

Dependent claims inherit those defects.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 41, 42, 10, 12-17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fiore (U.S. Pat. 3,889,661).

Fiore was described with respect to the claims in numbered paragraph 7, paper number 9 and in numbered paragraph 11, paper number 08202004. As to the newly added limitation to the "observation window adapted to isolate the light source from the lumen", note window (18,19) and col.4, lines 8-12 and col.5, lines 9-14. Taking the lighting head (24) as anticipating the connection means, the annular part (26, col.5, lines 5-9) reads on the light head which houses the light source (in recess 27). The tube conveying the insufflation medium does not contact the annular part (26). As to claim 42, the window (18,19) forms part of the connection means (it is at least attached to it).

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 2, 3, 5-8, 15-24, 28, 30, 31, 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiore in view of Sugiyama (Jap. Pub. No. 06-319691) for the reasons set forth in numbered paragraph 11 of the previous Office Action, paper number 08202004.

10. Claim 4, 9, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiore in view of Sugiyama and further in view of Shields (U.S. Pat. 5,061,239) for the reasons set forth in numbered paragraphs 12 and 13 of the previous Office Action, paper number 08202004.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiore in view of Dormia (U.S. Pat. 5,176,127).

Fiore discloses obturator comprising a ovate tip portion (21) and thus fails to disclose one having a hollow sleeve with a plurality of resiliently deformable petal formations. Dormia discloses the use of a obturator having a hollow sleeve with a plurality of resiliently deformable petal formations (12,16) as an alternative to the one disclosed by Fiore (note col.1, lines 24-47 of Dormia). It would have been obvious to one of ordinary skill in the art to have provided an improved obturator of Dormia for the one of Fiore for the reasons described by Dormia.

***Allowable Subject Matter***

12. Claims 26-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

13. Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive.

As to the Fiore reference, the Examiner has addressed the newly added limitations in the rejections made above. Cancellation of the limitation directed to the "contamination prevention means" from claim 41 caused the Fiore reference to now anticipate this claim. It is noted that certain dependent claims appear in the rejection under 35 USC 102(b) and additionally in the rejection under 35 USC 103(a). This is a result of the multiple dependency of certain dependent claims.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

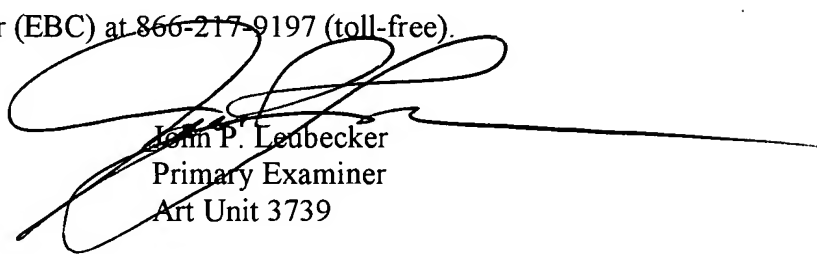
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl